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09/028,726	02/24/1998	MATTI JOKIMIES	297-007856-U	5120

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EXAMINER

APPIAH, CHARLES NANA

ART UNIT

PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 09/028,726

Filing Date: February 24, 1998

Appellant(s): JOKIMIES, MATTI

Henry R. Steckler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 31 July 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because appellant appears to read more into the invention as defined by the claims by stating that "the present invention presents a wide range of possibilities to control cell priorities related to one device ... ", (see page 2 section V of the Brief), however, the invention as defined by the claims is directed to a cellular radio system, terminal and method for realizing cell selection through prioritization.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,018,666 CHAVEZ, JR. 01-2000

5,649,289 WANG ET AL. 07-1997

ETSI (EUROPEAN TELECOMMUNICATIONS STANDARDS INSTITUTE) ETS 300 535
(GSM 03.22 version 4.10.0)

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 4, 6 and 7 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 25.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 25.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 25.

(11) *Response to Argument*

In response to Appellants' argument that "the pending claims clearly require that network to store and transmit to the mobile terminal certain terminal-specific information", specifically that claims 1, 3 and 6 recite "based on data specific to that terminal stored in and received from a network" and that Chavez do not anticipate these limitations, examiner respectfully disagrees with Appellants' statement that it is possible that the examiner confuses the concepts of "terminal-specific" and "pertaining to a

terminal". Examiner maintains that the claimed limitation of "data specific to that terminal" does not require nor indicate that the information has been created with only that terminal in mind" and as such Chavez's teaching of a wireless terminal consulting an internal list of base stations on which it is allowed to register, this list being transmitted from the wireless switching system (network) when the wireless terminal registers on the wireless switching system (see col. 3, lines 1-45) meets the claimed limitation of "at least one terminal is arranged to favor at least one cell based on data specific to that terminal stored in and received from the network". Examiner maintains that, at the time the terminal consults the internal list, that list is specific to that terminal and includes tenant identification numbers identifying tenants' whose base stations a mobile station is allowed to or can use. Examiner reiterates and maintains that the information that is made available to the mobile station including tenant identification numbers identifying tenants' whose base stations a mobile station is allowed or can use is tailored to that mobile station. Furthermore, Appellant appears to read more into the invention as claimed, however, it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), and as such the feature of "terminal-specific" meaning that "the information has been created with only that specific terminal in mind" are not recited in the claims. Chavez thus anticipates the invention as claimed with respect to claims 1-3, 4, 6 and 7.

Finally it is clear from Chavez that specific terminals are identified for each tenant, where different specific terminals are defined for different tenants

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In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Appellants' attempt to argue against the combination of Chavez and Wang in rejecting claims 5 and 8 and further the combination of Chavez and Wang with ETSI in rejecting claims 9 and 10 by stating that the there is no teaching or suggestion to combine the references, however, examiner maintains that the cited portions of the references as set forth in the rejections clearly provide ample suggestion and motivation to make the combinations, which would have been obvious those of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Charles Appiah
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PRIMARY EXAMINER

October 20, 2003

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